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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,296	01/19/2001	Richard B. Silberstein	D0097/7018	2845

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/700,296	SILBERSTEIN, RICHARD B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ardin Marschel	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 16-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-15, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) *4 sheets*
- 4) ☒ Interview Summary (PTO-413) *2 pages (copy)*
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 16-19, drawn to a system for evaluating the efficacy of therapeutic treatments of patients during a single cognitive task, classified in class 514, subclass 1.
- II. Claims 8-15, 20, and 21; drawn to a method for evaluating the therapeutic intervention in a patient corresponding to a first versus second cognitive task, classified in class 702, subclass 19.

The inventions are distinct, each from the other because:

The critical limitation in the inventions of Group I and Group II are unrelated.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to efficacy evaluation for therapy while the patient performs a single cognitive task, thus directly evaluating the efficacy of treatments in Group I whereas Group II is directed to evaluating the efficacy of therapeutic intervention via the comparison of differences between a first and second cognitive task.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mark Steinberg on April 23, 2002, a provisional election was made with traverse to prosecute the invention of Group II,

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claims 8-15, 20, and 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7 and 16-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### **TITLE**

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The elected invention is directed to methods whereas, in contrast, a system is cited in the title.

#### **VAGUENESS AND INDEFINITENESS**

Claims 8-15, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 contains several numbers such as "(10)" in the phrase "in a patient (10)" in line 1. These numbers cause the claim to be vague and indefinite as to what is meant thereby as being a limitation per se or not. It may be numbering as present in Figures, for example, but consideration of the Figures reveals that (10) in figure 1 points to "INTERNET". What therefore is meant by "patient(10)" where (10) is the INTERNET?

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Figure 3B on the other hand shows the number "40" as what appears to be a patient. What therefore is meant by the "(10)" in said line 1 of claim 8? This rejection is also applied to claims directly or indirectly dependent from claim 8 due to their dependence. Similarly, claim 15, line 9, cites the phrase "central analysis site (4)" whereas Figure 1 shows the item "(4)" as "CCS" which, in contrast, appears to abbreviate the words "Central Computer System" rather than an analysis site. Which wording is meant for item "(4)"? The metes and bounds of an analysis site and a computer system reasonably may be interpreted as different entities. Similarly, claim 20, and claim 21 by dependence, cites "central site (4)" in line 8, which also conflicts in meaning with the CCS of item 4 in Figure 1. Clarification via clearer claim wording is requested. It is suggested to remove the confusing numbering in the claims.

On the enclosed PTO Form 892 the U.S. Patent No. 6,052,619 is cited as being of interest in analyzing EEG signals in response to visual stimulation as in column 6, lines 40-46.

### **INFORMALITIES**

The disclosure is objected to because of the following informalities:

On the first page of the specification the U.S. Patent No. 4,955,938 is cited regarding SSVEP practice. However, confusingly, this Patent is directed to Ammunition.

Appropriate correction is required.

No claim is allowed.

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Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

September 19, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER